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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,310	05/31/2001	Robert Ainsworth	3764.P180	4544

8791 7590 04/20/2007  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025-1030

EXAMINER
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SMITH, RUTH S

ART UNIT	PAPER NUMBER
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3737

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/872,310

Applicant(s)

AINSWORTH ET AL.

Examiner

Ruth S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-21, 32-35, 44-46 and 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 9, 10, 13, 14, 34, 35 and 44-46 is/are rejected.
- 7) ☒ Claim(s) 1, 5, 7, 8, 11, 12, 15-21, 32-35 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/21/06</u> | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-4,9-10,13,14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2,9,13, positively set forth the fiber as being exposed within the vasculature of a patient thereby including the patient as part of the claimed invention. The inclusion of part of the part in the claimed invention renders the claims as being directed to non-statutory subject matter.

***Claim Objections***

Claims 1-5,7-21,32-35,48 are objected to because of the following informalities: In claim 1, line 7, "the optical fiber" lacks antecedent basis. In claims 2,5,9, "the optical fiber" lacks antecedent basis. In claim 8, it is unclear as to what structure has been positively set forth in order to limit the previous claim. In claims 12,18 it appears that the lumen is merely further defined by its intended use. It is unclear as to what further structural limitation has been set forth. In claim 15, the recitation of "the catheter capable of both diagnostic and therapeutic purposes" appears to be functional language unsupported by structure to produce such a function. Claim 19 is grammatically incorrect. In claim 19, "the optical fiber" lacks antecedent basis. In claim 32, line 9, "the optical fiber" lacks antecedent basis. In claim 33, lines 1-2 are grammatically incorrect. In claim 34, line 8, "the optical fiber" lacks antecedent basis. In claim 48, "the at least one light signal received from the proximal end" lacks antecedent basis. In claim 48, line 11, "the optical fiber" lacks antecedent basis. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34,35,44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Kittrell et al (5,199,431). The claims are directly readable on Kittrell et al which discloses an optical fiber catheter having at least three lumens used to detect reflected light signals to determine vessel or blood characteristics. With respect to claim 34, the structure set forth in not given any weight in the method claim unless used in a manipulative sense. With respect to claim 44, the lumens are capable of receiving any type of device. The specific structure of the device placed in a lumen fails to impose any further limitations on the claim in view of the use of the terminology "adapted to receive" which only sets forth intended use of the catheter.

#### ***Allowable Subject Matter***

Claims 1,5,7,8,11,12,15-21,32-33,48 would be allowable if rewritten or amended to overcome the objections set forth in this Office action.

#### ***Response to Arguments***

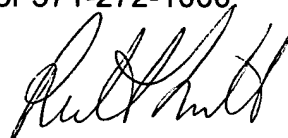
Applicant's arguments with respect to claims 1-5,7-21,32-35,44-46,48 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', is positioned above the printed name.

Ruth S. Smith  
Primary Examiner  
Art Unit 3737

RSS